



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/700,806	03/12/2002	Ben-Quan Shen	P1735R1	4225

7590 10/07/2004
DENISE M. KETRELBERGER
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

EXAMINER

HUNNICUTT, RACHEL KAPUST

ART UNIT PAPER NUMBER

1647

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/700,806

Applicant(s)

SHEN ET AL.

Examiner

Rachel K. Hunnicutt

Art Unit

1647

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See continuation sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: 18 and 19.Claim(s) rejected: 1, 8, 10, 14, 15 and 21.Claim(s) withdrawn from consideration: 16 and 17.


8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Continuation of 3. The rejection of claim 10 under 35 U.S.C. 112, second paragraph, is withdrawn in response to Applicant's amendment to the claim.

The rejection of claims 1, 8, and 10 under 35 U.S.C. 112, first paragraph, for lack of enablement for treating all NO-associated disorders, is withdrawn in response to Applicant's amendment to the claims.

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's arguments with respect to the rejection of claims 1, 8, 10, 14, 15, and 21 under 35 U.S.C. 112, first paragraph, for lack of enablement have been fully considered but have not been found to be persuasive. Applicants argue that they have disclosed the regions which are important for binding to the KDR receptor and the FLT-1 receptor, they have disclosed 29 different variants having KDR selectivity, and thus they have provided enough guidance so that the skilled artisan could obtain the desired VEGF variants.

As stated in the previous office action, the claims are drawn to methods of administering any VEGF variant that is selective for the KDR receptor. Such variants include substitutions, deletions, and insertions so long as the VEGF variant has the desired activity. The VEGF variants encompassed by the claims may have substitutions, deletions, or insertions anywhere within the VEGF sequence, however Applicants have only provided examples of substitutions occurring at residues 17, 18, 21, 22, 25, 63, 65, and/or 66. Similarly, the only VEGF receptor agonists are those provided in Table 2 of the specification. Applicants have not provided examples of any other VEGF receptor agonists that are selective for the KDR receptor other than the VEGF variants found in Table 2. Although the specification outlines art-recognized procedures for producing and/or screening for VEGF variants and VEGF receptor agonists, this is not adequate guidance as to the nature of active derivatives that may be constructed. It is merely an invitation to one of skill in the art to use the current invention as a starting point for further experimentation. What is provided is thus the idea for an invention and the invitation to experiment to implement this invention, but not the invention itself.


JANET ANDRES
PRIMARY EXAMINER